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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,904	04/10/2001	Sunil H. Contractor	BS00-363	7194
28970	7590	09/28/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			PHAM, THOMAS K	
		ART UNIT		PAPER NUMBER
		2121		
DATE MAILED: 09/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/828,904	CONTRACTOR, SUNIL H.
	Examiner	Art Unit
	Thomas K Pham	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 April 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-55 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

First Action on the Merits

1. Claims 1-55 of U.S. Application 09/828,904 filed on 04/01/2001 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

6. Claims 1, 3-4, 7-8, 18-24, 27, 30-31, 37-38 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,272,126 (“Strauss”).

Regarding claims 1 and 30

Strauss teaches contacting a user, comprising: receiving online session data (col. 7 lines 1-10, “The local ISP is supplied … destination telephone number”); processing the online session data to identify users to call (col. 8 lines 26-29, “The numbers shown in the … dial to reach the server”); and calling the users (col. 7 lines 11-17, “The destination computer … on the other of its lines”) [calling the users at the destination computer].

Regarding claims 3, 19 and 38

Strauss teaches the online session data includes a phone number (col. 9 lines 33-34, “The PC Server A … the caller’s number”).

Regarding claim 4

Strauss teaches the online session data includes a phone number and an address (col. 9 lines 49-55, “The originating PC Server … the destination ISP 144”).

Regarding claims 7 and 37

Strauss teaches comparing the session data to data of failed calls (col. 10 lines 3-8, “If the line 138 is busy … to the originating ISP 110”).

Regarding claims 8, 20 and 23

Strauss teaches the failed calls comprise one or more of busy calls or unanswered calls (col. 12 lines 63-66, “If the called party fails … to its ISP Server 416”).

Regarding claims 18 and 45

Strauss teaches contacting users, comprising: placing calls to users (col. 11 lines 55-58, “A caller at the originating ... with a directory number”); storing call details for calls not successfully completed (col. 12 lines 42-49, “If the line 438 is busy ... to the originating Voice Server 418”); comparing the call details to online session data (col. 12 lines 49-52, “The originating Voice Server ... busy condition on the called line”); and repeating phone calls to users based on the step of comparing (col. 12 lines 52-54, “the voice prompt to ... a designated key”).

Regarding claim 21

Strauss teaches receiving the call details from a telephone service provider (col. 8 lines 7-14, “the PC Server A is ... of the calling party”).

Regarding claim 22

Strauss teaches the telephone service provider stores the call details based on a trigger at a Service Switching Point (SSP) (col. 8 lines 35-45, “Each customer of the ... carrier network in New Orleans”).

Regarding claim 24

Strauss teaches the online session data is provided by an Internet Service Provider (ISP) (col. 7 lines 1-7, “The local ISP is ... the destination service provider”).

Regarding claim 27

Strauss teaches comparing phone numbers in the call details to phone numbers in the online session data (col. 12 lines 49-52, “The originating Voice Server ... busy condition on the called line”).

Regarding claim 31

Strauss teaches the means for receiving online session data comprises means for communicating with an Internet Service Provider (ISP) (col. 7 lines 1-7, “The local ISP is . . . the destination service provider”).

Claim Rejections - 35 USC § 103

7. Claims 9, 11-12, 29, 32-35 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strauss.

Regarding claims 9, 11 and 12

Strauss does not teach a third party other than the ISP and other than the user receives the session data; the third party is a telemarketer. “Official Notice” is taken for both the concepts and advantages of ISP providing subscribers’ phone numbers and other information is well known and expected in the art. A news report “Harried America Online Customers Now Face Calls by Telemarketers” by Boston Globe on July 24, 1997 said that ISP like AOL is providing member telephone numbers to telemarketer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the ISP to provide (or sales) the user data to any third party including telemarketer as long as there is no violation of member contracts.

Regarding claims 29 and 39

Strauss does not teach the step of repeating phone calls to users is automated. “Official Notice” is taken for the concept and advantage of automatically redial/dial phone calls is well known and expected in the art. U.S. Patent 6,438,599 discloses the telephone initiator can be done automatically by a computer software (see col. 5 lines 42-45). Therefore, it would have been obvious to one of ordinary skill in the art that the redialing features are well known and expected

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in a majority of telephone equipments at the time of the invention for the convenience of the caller.

Regarding claim 32-35

Strauss does not teach communicating comprises access to e-mail, a Web site, a facsimile or a direction connection for receiving a file containing the online session data. “Official Notice” is taken for both the concepts and advantages of ISP providing subscribers’ online session data via a Web site or providing in form of a file is well known and expected in the art. A news report “Harried America Online Customers Now Face Calls by Telemarketers” by Boston Globe on July 24, 1997 said that AOL is partnering with a Connecticut-based marketing firm (CUC) to sell products through a Web site shopping mall and also providing CUC files of member phone numbers for use in marketing effort. Therefore, it would have been obvious to one of ordinary skill in the art that many way of communication could be used at the time of the invention including via a Web site or to get member’s information on a file in anyway are well known and expected in the art.

8. Claims 2, 5-6, 10, 13-17, 25-26, 28, 36, 38, 40-44 and 46-55 are rejected under 35 U.S.C.

103(a) as being unpatentable over Strauss in view of U.S. Patent No. 6,714,931 (“Papierniak”).

Regarding claims 2, 5, 25 and 38

Strauss teaches the online session data identifies a user but does not teach the online session data identifies a user that has completed an Internet session. However, Papierniak teaches the online session data records indicates connection status including identifies a user that has completed an Internet session (col. 9 lines 59-63, “each of the data records . . . defined for a user”) for the

purpose of correlating Internet data with users and the transaction events. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the Internet data records of Papierniak with the system of Strauss because it would provide for the purpose of correlating Internet data with users and the transaction events.

Regarding claims 6, 28, 36 and 47

Strauss and Papierniak do not teach a determination of the time interval since an Internet session was completed. However, Papierniak teaches the online session data records including start and end times in user sessions (col. 10 line 46, “start and end times in user sessions”) for the purpose of correlating Internet data with users and the transaction events. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to base on the user start and end times during an online session for a determination of the time interval since an Internet session was completed.

Regarding claims 10 and 40

Strauss teaches identifying users to a caller, comprising storing a record of the online session (col. 9 lines 33-42, “page map 136 contains … the other type files”); and transmitting the record to a caller (col. 9 lines 53-55, “This datagram is delivered … to the destination ISP 144”).

Strauss does not teach detecting the end of an online session of a user. However, Papierniak teaches detecting the end of an online session of a user (col. 9 lines 59-63, “each of the data records … defined for a user”) for the purpose of correlating Internet data with users and the transaction events. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to base on the user start and end times during an online session for a determination of the time interval since an Internet session was completed.

Regarding claim 13

Strauss teaches transmitting is performed in substantially real time relative to the step of storing (col. 9 lines 56-60, “The destination ISP 144 . . . in the destination PC Server B”).

Regarding claim 14

Strauss and Papierniak do not teach the transmitting is performed within fifteen minutes.

However, Strauss teaches returning a busy signal if the line is busy (col. 10 lines 1-13, “The destination central office 130 . . . the busy condition on the called line”) for the purpose of notifying the user of a busy condition on the line. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the transmission of record is performed almost immediately (much less than 15 minutes) after the user initiated the call including notifying the user of a busy condition on the line as well known in the art.

Regarding claim 15

Strauss teaches the record includes a phone number of the user (col. 9 lines 33-34, “The PC Server A . . . the caller’s number”).

Regarding claim 16

Strauss teaches the record includes a phone number and an address of the user (col. 9 lines 49-55, “The originating PC Server . . . the destination ISP 144”).

Regarding claim 17

Papierniak teaches the record includes the time the online session ended (col. 9 lines 59-63, “each of the data records . . . defined for a user”).

Regarding claim 26

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Strauss teaches the identification includes a phone number (col. 9 lines 33-34, "The PC Server A ... the caller's number") and Papierniak teaches the end time of an online session (col. 10 line 46, "start and end times in user sessions").

Regarding claim 41

Papierniak teaches detecting comprises a remote access server (fig. 1, element 102).

Regarding claims 42 and 48

Strauss teaches storing a record comprises a database storing a phone number of the user (col. 9 lines 33-36, "The PC Server A collects ... the table 210 in FIG. 4") and Papierniak the time of the end of the online session (col. 10 line 46, "start and end times in user sessions").

Regarding claim 43

Strauss and Papierniak do not teach communicating comprises access to e-mail, a Web site, a facsimile or a direction connection for receiving a file containing the online session data. "Official Notice" is taken for both the concepts and advantages of ISP providing subscribers' online session data via a Web site or providing in form of a file is well known and expected in the art. A news report "Harried America Online Customers Now Face Calls by Telemarketers" by Boston Globe on July 24, 1997 said that AOL is partnering with a Connecticut-based marketing firm (CUC) to sell products through a Web site shopping mall and also providing CUC files of member phone numbers for use in marketing effort. Therefore, it would have been obvious to one of ordinary skill in the art that many way of communication could be used at the time of the invention including via a Web site or to get member's information on a file in anyway are well known and expected in the art.

Regarding claim 44

Strauss and Papierniak do not teach the session data is received by a third party other than the ISP and other than the user; the data is received by a telemarketer. “Official Notice” is taken for both the concepts and advantages of ISP providing subscribers’ phone numbers and other information is well known and expected in the art. A news report “Harried America Online Customers Now Face Calls by Telemarketers” by Boston Globe on July 24, 1997 said that ISP like AOL is providing member telephone numbers to telemarketer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention for the ISP to provide (or sales) the user data to any third party including telemarketer as long as there is no violation of member contracts.

Regarding claim 46

Strauss teaches comparing comprises a computer adapted to compare phone numbers in the call details to phone numbers in the online session data (col. 12 lines 49-52, “The originating Voice Server ... busy condition on the called line”).

Regarding claim 49

Strauss teaches the call details include whether a call was busy or unanswered (col. 12 lines 63-66, “If the called party fails ... to its ISP Server 416”).

Regarding claim 50

Strauss and Papierniak do not teach comparing the time interval to a threshold to determine whether a specific user is targeted for a repeat call. “Official Notice is take for the concept and advantage of automatically redial/dial phone calls is well known and expected in the art. U.S. Patent 6,438,599 discloses the telephone initiator can be done automatically by a computer software (see col. 5 lines 42-45). Therefore, it would have been obvious to one of ordinary skill

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in the art that the redialing features are well known and expected in a majority of telephone equipments at the time of the invention for the convenience of the caller.

Regarding claim 51

Strauss teaches a system for identifying users to call, comprising: an output module for sending the online session data to a third party caller (col. 9 lines 53-55, "This datagram is delivered ... to the destination ISP 144"). Strauss does not teach a remote access server for determining when an online session has ended; a memory for storing online session data including data sufficient to identify the time the online session ended. However, Papierniak teaches a remote access server for determining when an online session has ended (fig. 1, element 102); a memory for storing online session data including data sufficient to identify the time the online session ended (col. 9 lines 59-63, "each of the data records ... defined for a user") for the purpose of correlating Internet data with users and the transaction events. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the Internet data records of Papierniak with the system of Strauss because it would provide for the purpose of correlating Internet data with users and the transaction events.

Regarding claim 52

Papierniak teaches the online session data further includes data sufficient to identify a user associated with the online session (col. 9 lines 46-57, "A data record ... call duration").

Regarding claim 53

Strauss teaches the data sufficient to identify a user includes a phone number (col. 9 lines 33-34, "The PC Server A ... the caller's number").

Regarding claim 54

Strauss teaches the data sufficient to identify a user includes a name (col. 8 lines 26-31, "The numbers shown ... in the distal city").

Regarding claim 55

Strauss teaches the data sufficient to identify a user includes an address (col. 9 lines 49-55, "The originating PC Server ... the destination ISP 144").

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (703) 305-7587 or the new number (571) 272-3689 beginning around mid. October 2004, Monday - Friday from 8:00 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (703) 308-3179 (or 571 272-3687 starting around mid. Oct. 2004).

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.** Responses may also be faxed to the **official fax number (703) 872- 9306.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

September 24, 2004



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